



UNITED STATES PATENT AND TRADEMARK OFFICE

CLO

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------------|
| 09/765,316 | 01/22/2001 | Yoav Kimchy | 00/21350 | 9706 |
| 7590 | 03/15/2004 | | | EXAMINER VO, HIEU T |
| G.E. EHRLICH (1995) LTD. c/o ANTHONY CASTORINA SUITE 207 2001 JEFFERSON DAVIS HIGHWAY ARLINGTON, VA 22202 | | | ART UNIT 3747 | PAPER NUMBER |
| DATE MAILED: 03/15/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|---|
| Office Action Summary | Application No. | Applicant(s) | W |
| | 09/765,316 | KIMCHY ET AL. | |
| Examiner | Art Unit | | |
| HIEU T. VO | 3747 | | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 November 2003.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-60 is/are pending in the application.
 4a) Of the above claim(s) 50-60 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-49 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 03 November 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4, 5, 6</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Election/Restrictions

1. Receipt of Applicant's election without traverse of Group I including claims 1-49 in Paper No. 9 filed 11/03/2003 is acknowledged and placed in the file.
2. Claims 50-60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected of Group II, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 9 filed 03 November 2003.
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

4. A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the text in the whole disclosure is blurry due to the faxed copy has been submitted.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Sheppard, Jr. et al. (Pub. No. US 2002/0072784 A1).

Claims 1-49 are deemed broad enough to be descriptive of the device and method for wirelessly communicating with microchip devices of Sheppard, Jr et al. Attention is directed to Figure 3, a microchip device 50A at a first location such as stomach in the gastrointestinal (GI) tract, the microchip device 50B at a second location such as colon, and an RF transmitter 54 having an RF signal range shown by dash line 56. As the device pass through the GI tract, it moves from the position 50A, which is outside the RF signal range 56, to the position 50B, which is inside RF signal range 56 and can be powered by the signal from the RF transmitter 54 (see page 7, paragraphs [0064] and [0065]).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. References A-E and G are cited as being state of the art.

CONTACT INFORMATION

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HIEU T. VO whose telephone number is 703-308-1951. The examiner can normally be reached on M-F, 2nd Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HENRY C. YUEN can be reached on 703-308-1946. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HIEU T. VO
Primary Examiner
Art Unit 3747

3/7/04

HTV